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UNITED STATES DISTRICT COURT

CENTRAL DISTRICT OF CALIFORNIA

REYNALDO HERNANDEZ,) Case No.: 2:12-cv-04560-CAS-JC

Plaintiff,

v.

RODOLFO AVILA SANDOVAL, LOS
ALTOS BOOTS, INC., DOES 1-10,

Defendants.

LOS ALTOS BOOTS, INC., a
California corporation, and RODOLFO
AVILA SANDOVAL,

Counterclaimants,

v.

REYNALDO HERNANDEZ, and
ROES 1-10,

Counter-defendants.

**~~PROPOSED~~ PERMANENT
INJUNCTION ORDER**

Motion for Summary Judgment

Hearing Date: March 24, 2014

Time: 10:00 a.m.

Courtroom: 5 – 2nd Floor

ORDER

WHEREAS Counterclaim-Plaintiff, Rodolfo Sandoval Avila is found by this court to be the owner of the common law trademarks for “ORIGINAL MICHEL M SINCE 1970,” and “ORIGINAL MICHEL,” which includes both word marks and combination word and logo marks;

WHEREAS Counterclaim-Plaintiff Los Altos Boots, Inc. is the exclusive distributor of authentic boots advertised and sold bearing and/or using the common law trademarks for “ORIGINAL MICHEL M SINCE 1970,” and “ORIGINAL MICHEL,” which includes both word marks and combination word and logo marks;

WHEREAS Counter-Defendant Reynaldo Hernandez has been found by this Court to infringe the common law trademarks for “ORIGINAL MICHEL M SINCE 1970,” and “ORIGINAL MICHEL,” in his use of both the word marks and the combination word and logo marks when selling boots in the United States; and

WHEREAS the Court finds that the monetary relief is not enough to adequately compensate Counter-Plaintiffs for the losses caused by the Counter-Defendant’s infringement of the marks.

IT IS HEREBY ORDERED AND DECREED that:

A. Under 15 U.S.C. §1116, Counter-Defendant Reynaldo Hernandez, together with his principals, affiliates, licensees, manufacturers, importers, partners, managers, suppliers, agents, attorneys, employees, employers, representatives, successors, assigns, transferees, and all persons acting in concert or participation with him, or at his direction, or within his control, shall be permanently enjoined and restrained from engaging in any of the following:

1. Using the ORIGINAL MICHEL M SINCE 1970 and ORIGINAL MICHEL trademarks or any other name or mark confusingly similar to ORIGINAL MICHEL M SINCE 1970 and ORIGINAL MICHEL, that includes the words or symbols for “ORIGINAL,” “MICHEL,” “SINCE 1970” or any confusingly

1 similar variation of those words or symbols in any manner.

2 2. Manufacturing, producing, importing, labeling, selling, distributing, licensing,
3 sub-licensing, assigning, marketing, promoting, or advertising boots, work
4 boots, cowboy boots, shoes, tennis shoes, hats, sandals or apparel in any
5 manner that:

- 6 a. uses the ORIGINAL MICHEL M SINCE 1970 and ORIGINAL
7 MICHEL trademarks or any other name or mark confusingly similar to
8 ORIGINAL MICHEL M SINCE 1970 and ORIGINAL MICHEL, that
9 includes the words or symbols for “ORIGINAL,” “MICHEL,” “SINCE
10 1970” or any confusingly similar variation of those words or symbols in
11 any manner; or
- 12 b. uses the ORIGINAL MICHEL M SINCE 1970 design mark (shown
13 immediately below), or any other mark that consists of a circle with a
14 rope design lining the outer edge of the circle, with a band lining the
15 inside of the circle with “ORIGINAL MICHEL” across the top of the
16 circle, with “SINCE 1970” on bottom of the circle with a pair of
17 cowboy boots heel to heel with an M in the center, with the silhouette
18 of a bull’s head in the center of the M (or any confusingly similar
19 variations);



or

- c. uses the ORIGINAL MICHEL M SINCE 1970 SINCE 1970 BOOTS COMPANY design mark (shown immediately below), or any other confusingly similar mark that consists of a colored ribbon in the shape of a horse shoe with the two extended ends revealing the back of the ribbon with V-cutout at the tips of the ribbon, a star followed by "ORIGINAL MICHEL" followed by another star on the arch of the horse shoe design, the side silhouette of two cowboy style boots placed back to back with an "M" in block lettering in the center of the boots with a bull head in the center of the "M". "SINCE 1970" in lettering between the center of the two ends of the horse shoe design and the words "BOOTS COMPANY" at the bottom (or any confusingly similar variations);



or

- d. uses in or on any boxes, bags, labels, or imprinting on the footwear itself, any of the marks described in items 1a-1c (hereinafter referred to as an "ORIGINAL MICHEL marks"), or any other mark that includes the words "ORIGINAL," "MICHEL," "SINCE 1970" or any

1 confusingly similar variation of those words.

2 3. Distributing, advertising, marketing, promoting, selling, renting, licensing,
3 sublicensing, assigning, or participating in any other exploitation of the
4 ORIGINAL MICHEL marks (or any confusingly similar variations thereof) in
5 connection with boots, work boots, cowboy boots, shoes, tennis shoes, hats,
6 sandals and any other items of apparel.

7 B. Reynaldo Hernandez shall make good faith requests in writing to all of his
8 suppliers, domestic distributors, importers, wholesalers, licensees, employers, sub-
9 licensees, assignees, and retailers that he knows or has reason to believe received
10 any products bearing and/or using the ORIGINAL MICHEL marks (1) to cease all
11 advertising, distribution, importing, sale, marketing, promotion, or other exploitation
12 of the ORIGINAL MICHEL marks (or any confusingly similar variations thereof),
13 including in connection with any boots, work boots, cowboy boots, shoes, tennis
14 shoes, hats, sandals, or apparel (2) to remove all stock using the ORIGINAL
15 MICHEL mark (or any confusingly similar variations thereof) from any method or
16 manner of distribution and return such products to Reynaldo Hernandez, who shall
17 then deliver them to Defendants for destruction, and (3) to request in writing that
18 their respective licensees, sub-licensees, assignees, customers, retailers, importers
19 and other downstream recipients of the counterfeit ORIGINAL MICHEL products
20 comply with the requirements of parts (1) and (2) of this Section B.

21 C. Reynaldo Hernandez shall provide written notice of this Permanent
22 Injunction Order (1) to each of his principals, partners, importers, shareholders,
23 agents, employees, employers, attorneys, representatives, successors, assigns,
24 licensees, affiliated entities, and/or all entities under his control, and (2) to all
25 suppliers, distributors, importers, manufacturers, wholesalers, licensees, sub-
26 licensees, assignees, retailers, and/or any other persons or entities acting in concert
27 with Reynaldo Hernandez that he knows or has reason to believe received the
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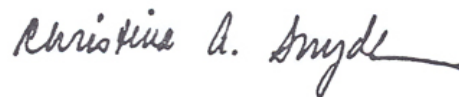
1 counterfeit ORIGINAL MICHEL products (or any confusingly similar variations
2 thereof), as well as to all domestic retailers and other distributors that Defendants are
3 requesting in writing that Reynaldo Hernandez so notify. Reynaldo Hernandez shall
4 provide a copy of the Permanent Injunction Order as part of any such notice, which
5 may be transmitted by email.

6 D. Reynaldo Hernandez shall provide Counterclaim-Plaintiffs with a list of
7 all suppliers, distributors, importers, manufacturers, wholesalers, licensees, sub-
8 licensees, assignees, retailers, and/or any other persons or entities acting in concert
9 with Reynaldo Hernandez that he knows or has reason to believe supplied,
10 distributed, imported, manufactured, received, sold, and or licensed the counterfeit
11 ORIGINAL MICHEL products (or any confusingly similar variations thereof)

12 E. Within thirty (30) days of the date of entry of this Permanent Injunction
13 Order, Reynaldo Hernandez shall serve Counterclaim-Plaintiffs with a report in
14 writing and under oath setting forth the manner in which he has complied with
15 Sections B and C of this Permanent Injunction Order, by providing (1) a copy of any
16 notice or communication sent to anyone by Reynaldo Hernandez regarding the
17 Permanent Injunction Order, (2) a list of all persons and entities to whom such
18 notice or communication was sent and (3) turning over all of the infringing goods
19 bearing the ORIGINAL MICHEL marks received for destruction by Counterclaim-
20 Plaintiffs.

21 F. This Court shall retain, continuing jurisdiction for purposes of enforcement
22 of the Permanent Injunction Order. Violation of the Permanent Injunction Order
23 shall expose Reynaldo Hernandez and all other persons bound by the Judgment to all
24 applicable penalties, including contempt of Court.

25 Dated: April 21, 2014



26 _____
27 Honorable Christina A. Snyder
28 United States District Court Judge